

## REMARKS

With the entry of this Amendment, claims 1-20 will be pending in this patent application. Claims 5-16, drawn to a non-elected species, stand withdrawn from further consideration. New claims 18-20 depend from claim 17, which, Applicant submits, is allowable and generic.

### PRIOR ART REJECTION I

Claim 1 was rejected under 35 USC § 102(b) as being anticipated by or, alternatively, under 35 USC § 103(a) as being obvious over US 6319150 B1 (Werner et al.). Applicant respectfully traverses this rejection.

Claim 1 recites a golf club head in which a maximum resilience point is displaced from a center of a hitting surface in a direction above the center.

In the golf club face structure disclosed by Werner et al., the thickness of the clubface diminishes in directions away from the face center. There is no disclosure in Werner et al. that the reduction in face thickness away from the center alters the position of a maximum resilience point. Nor is there any disclosure in Werner et al. that such a displacement is desired. In fact, due to the *uniform* reduction of the clubface thickness *in all directions away from the center*, as clearly shown in Fig. 3, no displacement of a maximum resilience point will occur; the maximum resilience point will coincide with the center of the clubface.

As disclosed in this application, a shifting of the point of maximum resilience can be effected by *non-uniform* thinning of the clubface in directions toward the top, toward the bottom, toward the toe and toward the heel. For example, as described in the specification of this application on page 7, lines 5-6, thinning of the clubface above the center will cause the maximum resilience point to be located above the center, as in the clubface illustrated in Fig. 4.

In view of the foregoing observations, Applicant submits that the disclosure in Werner et al. cannot properly serve as a basis for rejecting claim 1 under 35 USC § 102(b). Also, since there is no disclosure or suggestion in Werner et al. of a clubface in which a maximum resilience point is located away from the center of the clubface, as required by claim 1, there is no basis on which to conclude that the disclosure in Werner et al. would make obvious a clubface having such properties.

## PRIOR ART REJECTION II

Claims 2-4 were rejected under 35 USC § 103(a) as being unpatentable over Werner et al. Applicant respectfully traverses this rejection.

In the discussion above, Applicant has shown why Werner et al. cannot properly serve as a basis for rejecting independent claim 1 under 35 USC § 103(a). The patentability of claim 1 obviously inheres in dependent claims 2-4. Moreover, the dependent claims recite additional patentable departures from the disclosure in Werner et al. There is, for example, no disclosure in Werner et al. that makes obvious the value of  $(t_2 - t_1)$  on the maximum resilience point, as recited in claim 4.

Applicant disagrees with the Examiner's statement regarding the applicability of USGA specifications for the value  $(t_2 - t_1)$  to Applicant's claim 4. As pointed out, for example, in Applicant's specification, on page 7, lines 19-21, the USGA rules relating to the value  $(t_2 - t_1)$  apply to measurements at the center of the clubface, not at a maximum resilience point, as recited in claim 4.

In view of the foregoing observations, Applicant submits that the disclosure in Werner et al. cannot properly serve as a basis for rejecting any of claims 2-4.

## PRIOR ART REJECTION III

Claim 17 was rejected under 35 USC § 102(b) as being anticipated by US 5028049 (McKeighen). Applicant respectfully traverses this rejection insofar as it might be deemed applicable to claim 17, or to new claims 18-20, as now presented.

In this paper, Applicant has amended claim 17 to specify the maximum resilience point as being displaced from the coordinates (0, 0). Applicant has also amended claim 17 to recite limitations that are also recited in claims 3 and 4.

The Examiner cites McKeighen as disclosing a golf club with a striking face that is thinnest at its center, with a maximum resilience point at coordinates (0, 0). Clearly McKeighen offers no disclosure that can meet (or make obvious) the requirement in claim 17 that the maximum resilience point is displaced from the coordinates (0, 0), much less the claimed combination of this feature and the values for  $(t_2 - t_1)$  on the center of the hitting surface and on the maximum resilience point.

In view of the foregoing observations, Applicant submits that McKeighen cannot properly serve as a basis for rejecting claim 17 as now presented under 35 USC § 102(b).

Applicant submits that claim 17 is generic to all of the species identified by the Examiner on page 2 of the February 6, 2006 Requirement for an Election of Species. Furthermore, claim 17 is allowable for reasons presented above. New claims 18, 19 and 20 recite features that are also recited in claims 6, 10 and 14, respectively. Since new claims 18-20 depend from claim 17, Applicant submits that they should be recognized as allowable along with claim 17.

#### OTHER PRIOR ART

Applicant has considered the other prior art cited by the Examiner. Applicant is not commenting on this prior art, because it was not applied against the claims in this application.

#### CONCLUSION

In view of the amendments, observations and arguments presented herein, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections stated in the outstanding Office Action and recognize all of the pending claims as allowable.

If unresolved matters remain in this application, the Examiner is invited to contact Frederick R. Handren, Reg. No. 32,874, at the telephone number provided below, so that these matters can be resolved expeditiously.

Application No. 10/791,845  
Amendment dated August 18, 2006  
Reply to Office Action of May 18, 2006

Docket No.: 3673-0170P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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